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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,136	11/14/2001	Sonna Calandrino	2022.002	4652

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HESLIN ROTHENBERG FARLEY & MESITI PC  
5 COLUMBIA CIRCLE  
ALBANY, NY 12203

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992,136

Applicant(s)

CALANDRINO

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 26-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 26-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed June 28, 2004, has been entered. Claims 1, 10, 15, 19, 20, 26, 30, 31, 37, 43, 45, and 54-56 have been amended. Claims 24 and 25 have been cancelled, while new claims 70-98 have been added. Thus, the pending claims are 1-23 and 26-98.
2. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejection set forth in section 5 of the last Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 57-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 57 is rejected as being indefinite for lacking antecedent basis for the phrase "the image mounted in the second region." Claims 58-60 are also rejected for their dependency upon 57.

### ***Double Patenting***

5. Applicant is advised that should claim 44 be found allowable, claim 65 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-18, 26-29, 33-42, 45-51, and 53 stand rejected under 35 USC 103(a) as being unpatentable over US 5,461,748 issued to Koiduka for the reasons of record.

***Response to Arguments***

8. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.
9. Applicant amends the claims to limit the second region of a second material to having *a legend providing* the information related to the image of the first region. Applicant asserts the examiner agreed in the Interview of February 3, 2004 that such an amendment would be sufficient to place the claims in condition for allowance. The examiner respectfully disagrees that an indication of allowable subject matter was discussed. Rather, it was noted that an amendment including "legend" would limit the type of relationship between the image and the information of the two regions. [Note section 10 of the last Office Action.] At best, during the interview, it was indicated that such an amendment would likely overcome the standing prior art rejection.

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10. However, upon further review of the case, said prior art rejection is maintained.

Specifically, it is argued that the image and legend of information are merely **printed matter** features. *In re Gulack*, 217 USPQ 401 states, "Printed matter that is not functionally related to substrate does not distinguish invention from prior art in terms of patentability; although printed matter must be considered, in that situation it may not be entitled to patentable weight."

Additionally, *In re Seid*, 73 USPQ 431 found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. As such, the legend and image cannot serve to patentably distinguish the present invention over the prior art.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 54, 56, 75, 76, 78-82, 91, 92, and 94-98 are rejected under 35 USC 102(a) as being anticipated by Organdy Pocket Panel curtains advertised in Pottery Barn Kids, Spring 2000 catalog, page 86-87.

Said curtains show an article of manufacture comprising (a) a first region of a first textile material having an image (e.g., fish), (b) at least one second region of a second material having a legend providing at least some info relating to said image (e.g., words relating to fish), and (c) a plurality of pockets. Thus, claim 56, 91, 92, 94-96, and 98 are anticipated.

With respect to claims 54, 75, 76, 78-80, and 82, it is argued that the preamble limitation of a floor covering is merely descriptive of an intended use. Said limitation does not add any further structure to the article. Hence, said claims are also anticipated.

With respect to claims 81 and 97, it is argued that the articles within the pockets of the curtain can be interpreted as a toy. Hence, said claims are also anticipated.

***Claim Rejections - 35 USC § 103***

13. Claims 77 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Pottery Barn curtain.

Although said curtain does not teach a removably mounted pocket. It would have been obvious to one skilled in the art to produce said pocket by a removable method of attachment. Motivation to do so would be to produce a product that is easily customized by a consumer. Therefore, claims 77 and 81 are rejected as being obvious over the cited prior art.

14. Claims 1-23, 26-30, 33-43, 45-53, and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,336,289 issued to Davis.

With respect to claim 19, Davis teaches the steps comprising (i) providing a substrate (i.e., base fabric or primary backing), (ii) attaching a first material to the substrate (i.e., tufting or weaving pile yarns into base fabric), (iii) providing at least one void by removing at least some of the first material (i.e., carving out pile yarn), (iv) providing at least one second material (i.e., inlay section), and (v) mounting the second material in the void (i.e., inserting piece of like shape into trough and adhesively bonding thereto) (abstract and col. 3, lines 40-68). Thus, Davis teaches the claimed invention with the exception of providing an image on the first material.

However, it would have been readily obvious to one skilled in the art to print or dye an image on the carpet of the first region in order to provide an aesthetically pleasing article.

With respect to the limitation that the second material has some information related to the image, it is argued that said limitation is not given patentable weight at this time since said limitation amounts to a design feature of printed matter. Therefore, claim 19 and the other noted process claims are rejected.

The product claims are similarly rejected since Davis teaches a first region of a first textile material, said region having a perimeter and at least one void, wherein a second material is positioned within said void. The second material of Davis differs from the first material in texture, material, or pattern (abstract). As previously argued, it would have been obvious to one skilled in the art to print or dye an image thereon. Additionally, it is argued that the limitations of images and legends are design features of printed matter and cannot serve to patentably distinguish the present invention from the prior art. Therefore, said product claims are also rejected.

15. Claims 31, 32, 44, 57-60, 61-64, 665-69, and 74 are rejected under 35 USC 103(a) as being unpatentable over the cited Davis patent.

Davis does not explicitly teach the claimed needlework. However, it is well known in the art to employ needlework such as embroidery to personalize and/or advertise, for example, a company logo. Applicant is hereby given Official Notice of this fact. Thus, it would have been readily obvious to one skilled in the art to employ needlework to produce an aesthetically pleasing article that is personalized or able to function as advertisement. Therefore, said claims are rejected over the cited Davis patent.

*Allowable Subject Matter*

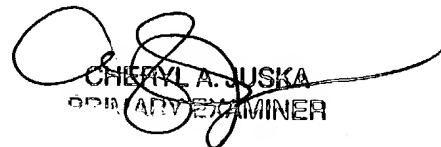
16. Claims 55 and 83-90 are allowed for the reasons of record.

*Conclusion*

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER